

### **REMARKS / ARGUMENTS**

The present application includes pending claims 1-37, all of which have been rejected. The Applicant respectfully submits that the claims define patentable subject matter.

Claims 1-7, 10, 11-17, 20, 21-27, 30-32, 34 and 36 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over USPP 2002/0104099 ("Novak"), in view of USP 6,628,303 ("Foreman"). Claims 8-9, 18-19 and 28-29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Novak and Foreman, in view of USP 7,284,032 ("Weber"). The Applicant respectfully traverses these rejections at least for the reasons previously set forth during prosecution and at least based on the following remarks.

### **REJECTION UNDER 35 U.S.C. § 103**

In order for a *prima facie* case of obviousness to be established, the Manual of Patent Examining Procedure, Rev. 6, Sep. 2007 ("MPEP") states the following:

The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Federal Circuit has stated that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness."

See the MPEP at § 2142, citing *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), and *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval). Further, MPEP § 2143.01 states that “the mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art” (citing *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007)). Additionally, if a *prima facie* case of obviousness is not established, the Applicant is under no obligation to submit evidence of nonobviousness.

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

See MPEP at § 2142.

**I. The Proposed Combination of Novak and Foreman Does Not Render Claims 1-7, 10, 11-17, 20, 21-27, 30-32, 34 and 36 Unpatentable**

**A. Independent Claims 1, 11 and 21**

With regard to the rejection of independent claim 1 under 35 U.S.C. § 103(a), the Applicant submits that the combination of Novak and Foreman does not disclose or suggest at least the limitation of “editing, at said first geographic location, previously created metadata associated with said media content, said editing based on said additional media content,” as recited by the Applicant in independent claim 1.

The Office Action states the following:

In reference to Claim 1, Novak teaches a method for producing and delivering media content (as shown in Figs. 4 and 11; with further reference to the descriptions of Paragraphs [0056-0060; 0077-0086]), the method comprising:

establishing a personal television channel at a first geographic location ("Joe's TV Channel" as shown in Figs. 6-9 created by the method of Figs. 4 and 11; With further reference to the operations of Upload Source 122, as described in Paragraphs [0039,0040,0041,0046,0055,0056, 0068,0070,0074, and 0080])

modifying existing media content to produce a media program (Fields 706 of Fig. 7 allow an individual to enter media object information or preferences, such as identifiers for date, time slot, media object identifier (10), media object description, or file type, as described in Paragraph [0063-0067]. Once the individual has entered the media object information or preferences, the media objects are then compiled into the media program of Display 710, as described in Paragraph [0067]);

editing, at said first location geographic location, metadata associated with said media content (Fields 706 are customized by the individual, as described in Paragraphs [0063-0067]. In addition, the interface of Fig. 6 allows the uploading individual to create and edit a program schedule for Synthetic Channel);

associating the produced media program and said edited metadata with the established personal television channel (EPG 802 of Fig. 8 and EPG 152 of Fig. 9, which show "Joe's TV Channel" in association with the broadcast times and Conventional Television Broadcast Channels of EPG 802, as described in Paragraphs [0071,0072])

communicating said produced media program along with said edited metadata to another geographic location ("Joe's TV Channel" is then communicated to the end user of STB 152 according the schedule times established by Upload Source 122, as described in Paragraphs [0059,0072]. In addition, the metadata edited by Upload Source such as program titles, scheduled broadcast times, and object IDs are

communicated with the program content to the end user, as shown in Figs. 8 and 9, which correspond to the data of Fig. 7).

However, it is unclear within the disclosure of Novak if the existing media content is modified with additional media content to produce the media program and if the editing process includes editing previously created metadata based on said additional media content.

In a similar field of invention, Foreman teaches a graphical user interface for producing a video program using planning, capturing, editing, and recording functions (Abstract). Foreman further discloses Interface 56 of Fig. 9 that allows a user to modify media content with additional media content such as transitions between clips (using effects tab Interface 153, as described in Col. 15 Lines 13-39; with further reference to Fig. 10), titles (using titles tab Interface 154, as described in Col. 15 Line 40-Col. 16 Line 7; with further reference to Fig. 11), and sounds such as voice-over commentary (using sound tab Interface 155, as described in Col. 16 Lines 8-27; with further reference to Fig. 12 and Interface 220). Additionally, Fig. 16 of Forman demonstrates "an example operation in which the clip descriptions and shot descriptions are synchronized" (Col. 10 Lines 56-58). In particular, at Step 226 of Fig. 16 metadata is associated with a media program ("Associate Data File With a Clip" of Fig. 16, as described in Col. 10 Lines 60-65). Then at Step 230, a process of editing the previously created metadata (from Step 226) is performed based on additional media content ("description modifies its duration and pointer to reference the new clip description", as shown in Fig. 16 and described in Col. 10 Line 65-Col. 11 Line 2; with further reference to Col. 11 Line 3-Col. 12 Line 31).

See Office Action at pages 6-8. In the above argument, the Examiner has equated Applicant's modifying of the existing media content to Novak's completion of fields 706 (entering media object information or preferences). The Applicant respectfully disagrees and points out that entering of the media object information and preferences do not include any modification to the related media content. In other words, there really isn't any modifying of existing media content by Novak's user interface 702. Novak's content, as created by the upload source, stays the same and related

information and preferences are added only for purposes of organizing the synthetic channel.

Furthermore, the Examiner has equated Applicant's editing of metadata with Novak's customization of fields 706, as described in paragraphs 0064-0067 and Fig. 7 of the reference. More specifically, the Examiner alleges that the information described by headings 704 (e.g., date, time slot, file type, media object description, etc) is equivalent to Applicant's metadata. Even if we assume, arguendo, that the headings 704 are metadata for the corresponding media files, the Office Action is still deficient. More specifically, **the information described by headings 704 is not "previously created metadata."** Fig. 7 of Novak illustrates the user interface that can be used to create the synthetic channel. Obviously, the information described by headings 704 is being currently created by the user interface in the process of setting up the synthetic channel, and it is not previously existing (or previously created). At most, Novak, in Fig. 7, discloses creation of new metadata, not modification/editing of previously created metadata.

Furthermore, even if we assume, arguendo, that Fig. 7 illustrates editing of "previously created metadata", the Final Office Action is still deficient. More specifically, **Novak, including Fig. 7, does not disclose that such editing of metadata is based on the additional media content used to modify the existing media content.**

It seems the Examiner agrees with the above arguments as he states the following in page 6 of the present Office Action:

However, it is unclear within the disclosure of Novak if the existing media content is modified with additional media content to produce the media program and if the editing process includes editing previously created metadata based on said additional media content.

The Examiner then relies for support on Foreman. Before addressing the deficiencies of Foreman, the Applicant points out the following statement by the Examiner, appearing in page 4 of the Office Action:

The Examiner construes Applicant's amended "previously created" and "said editing based on said additional media content" to pertain to the "additional media content" and submits that Foreman teaches the amended limitations as addressed below in the current Office action. (emphasis added)

The Applicant respectfully disagrees, especially with the above underlined statement. Applicant's claim 1 (as well as claims 11 and 21) very clearly recites "**previously created metadata** associated with said media content". Obviously, "previously created" pertains to the media content (prior to modifying the media content with the additional media content), and it does **not** pertain to the "additional media content" per se, as stated by the Examiner.

1. Foreman's Storyboard Descriptions Are Not Previously Created Metadata Associated with Media Content

Foreman discloses a graphical user interface for a computer-assisted motion video editing system. More specifically, computer system 20 offers a "storyboard"

interface 52, a “bring video in” interface 54, an “edit movie” interface 56, and a “send movie out” interface 58.

The storyboard interface 52 enables a user to plan the motion video program to be prepared. More specifically, the storyboard interface 52 can be represented by the data structure 86 of shot descriptions 87 (Fig. 6), which stores a pre-planned outline for each shot (e.g., shot title, filming/editing tips, duration and pointer to the video file). In other words, the storyboard interface 52 is used by the user in the planning stage of video production, where the user makes an outline (or a story line) by selecting how many shots his video will have, what titles, etc. **All the steps of creating the storyboard shot descriptions 87, however, are created prior to bringing the video in** (which is the subsequent step done by interface 54). See, e.g., Foreman, at col. 7, line 25 – col. 8, line 30. **Consequently, when the storyboard shot descriptions 87 are created, they are not metadata (or “previously created metadata) as they are not associated with any video data (as there is no video brought in for editing).**

2. Foreman’s FIG. 16 Does Not Disclose Editing of Previously Created Metadata

The Applicant points out that the metadata related to the video file (after it is brought in via interface 54) is represented by data structure 88 (fig. 7). Referring to Foreman’s Fig. 16, after video data is captured in steps 222 and 224, a data structure 88 is created, which describes the captured video clip. The Applicant notes that the storyboard shots descriptions have already been created prior to capturing the video.

After the video clip is captured and its data structure 88 is created, at step 228, a message is sent to the storyboard indicating that a clip with certain duration was created. Since the captured clip is for a specific shot description (87), the storyboard, in step 230, records the clip duration (98) and the pointer (100) to the captured clip location. It is at this point (in step 230) that the specific shot description (87) is in fact associated with actual (captured) video data. As explained above, prior to capturing the video data, the storyboard shot descriptions 87 simply form an outline and cannot be considered a metadata as they are not actually associated with any video data. Therefore, Foreman (in steps 228-230 of Fig. 16) does not disclose any editing of previously created metadata as there was simply no metadata prior to the actual capturing of the video data.

The Examiner's argument (e.g., pages 6-7 of the Office Action) cites to various other portions of Foreman. However, such citations are mostly related to the video editing functionalities of the computer system 20 of Foreman, and they do not relate to editing of previously created metadata.

Therefore, the Applicant maintains that the combination of Novak and Foreman does not disclose or suggest at least the limitation of "editing, at said first geographic location, previously created metadata associated with said media content, said editing based on said additional media content," as recited by the Applicant in independent claim 1.



Accordingly, the proposed combination of Novak and Foreman does not render independent claim 1 unpatentable, and a *prima facie* case of obviousness has not been established. The Applicant submits that claim 1 is allowable. Independent claims 11 and 21 are similar in many respects to the method disclosed in independent claim 1. Therefore, the Applicant submits that independent claims 11 and 21 are also allowable over the references cited in the Office Action at least for the reasons stated above with regard to claim 1.

**B. Rejection of Dependent Claims 2-7, 10, 12-17, 20, 22-27, 30-32, 34 and 36**

Based on at least the foregoing, the Applicant believes the rejection of independent claims 1, 11 and 21 under 35 U.S.C. § 103(a) as being unpatentable over Novak in view of Foreman has been overcome and requests that the rejection be withdrawn. Additionally, claims 2-7, 10, 12-17, 20, 22-27, 30-32, 34 and 36 depend from independent claims 1, 11 and 21, respectively, and are, consequently, also respectfully submitted to be allowable based on the above arguments.

The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 2-7, 10, 12-17, 20, 22-27, 30-32, 34 and 36.

**II. The Proposed Combination of Novak and Foreman Does Not Render Claims 8-9, 18-19 and 28-29 Unpatentable**

Based on at least the foregoing, the Applicant believes the rejection of independent claims 1, 11 and 21 under 35 U.S.C. § 103(a) as being anticipated by Novak has been overcome and requests that the rejection be withdrawn. Additionally, since the additional cited reference (Weber) does not overcome the deficiencies of Novak, claims 8-9, 18-19 and 28-29 depend from independent claims 1, 11 and 21, respectively, and are, consequently, also respectfully submitted to be allowable based on the above arguments. The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 8-9, 18-19 and 28-29.

In general, the Office Action makes various statements regarding claims 1-37 and the cited references, which statements are now moot in light of the above. Thus, the Applicant will not address such statements at the present time. However, the Applicant expressly reserves the right to challenge such statements in the future should the need arise (e.g., if such statement should become relevant by appearing in a rejection of any current or future claim).

**CONCLUSION**

Based on at least the foregoing, the Applicant believes that all claims 1-37 are in condition for allowance. If the Examiner disagrees, the Applicant respectfully requests a telephone interview, and requests that the Examiner telephone the undersigned Attorney at (312) 775-8176.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to the deposit account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

A Notice of Allowability is courteously solicited.

Respectfully submitted,

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